

REMARKS

Claims 1-13 and 21-44 currently remain in the application. Claims 1, 21, 24 and 35 have been amended.

In office communication of 10/23/2003 Examiner indicated that the limitation of "wherein the gaming machine is operable to award the selected non-cash prize as a result of only the game of chance to be played following the prize selection, independent of any previous games of chance played on the gaming machine and to only redeem non-cash prizes that are awarded in this manner" raises issues of new matter. This limitation has been modified to read "wherein the gaming machine is operable to award the selected non-cash prize as a result of only the game of chance to be played following the prize selection, independent of any previous games of chance played on the gaming machine and to only provide prize redemption of non-cash prizes that are awarded in this manner" for the purposes of clarification. Applicant believes this limitation does not raise new matter. The portion of the limitation "wherein the gaming machine is operable to award the selected non-cash prize as a result of only the game of chance to be played following the prize selection, independent of any previous games of chance played on the gaming machine" describes the well-known method of how casino gaming machines award prizes.

In a casino gaming machine, a player makes a wager on a game of chance and then an outcome for the game of chance is determined using a random number generator and a payable on the gaming machine. As is well known in the gaming industry, the payable uses independent probabilities that do not depend on the outcome of previous games. Page 1, line 20-Page 2, line 26 is one place that describes the pay-out table (e.g., usually, the jackpot, the pay-out table and the odds for each outcome in the pay-out table are fixed on a single gaming machine and may not be changed by the player.) On page 3, line 10-11, it states the odds of winning the jackpot are fixed when the player initiates a game on the gaming machine. On page 17, 3-13, it states, "when the player initiates a game, the gaming machine selects the appropriate pay table for the prize or prizes selected and presents a game outcome to the player in the display area 418. The pay tables corresponding to different prizes and may be stored in a memory location 424 residing within the gaming machine 400. It may also be configured on a master gaming controller of the gaming machine. When a specific outcome of a game occurs corresponding to a pay-out of the selected prize, the player wins the selected prize." Thus, "the gaming machine is operable to award the selected non-cash prize as "a result of only the game of chance to be played following the prize selection, independent of any previous games of chance played on the gaming machine." (see also FIG. 7 for more details)

As described in the specification, the gaming machine also only provides prize redemption of non-cash prizes that are awarded as a result of only the game of chance to be played following the prize selection, independent of any previous games of chance played on the gaming machine. One way the gaming machine provides redemption of prizes is described with respect to FIG. 1, page 9, line 23-26 where it states, "after the player has completed a game, the player may receive game tokens from the coin tray or the ticket 20 from the printer 18, which may be used for further games or to redeem a prize." Another way that the gaming machine may provide prize redemption is via a prize server and a prize fulfillment center as is described on page 17, line 29-page 18, line 4 where it states, "in one embodiment, the prize server 402 may be connected to a prize fulfillment center 450. Thus, when a player wins a specific prize on the gaming machine 400, the prize information is sent from the gaming machine to the prize server 402. Then, the prize information is sent over a network 452 to the prize fulfillment center 450. The purpose of the prize fulfillment center is to acquire and transfer the prize won by the player to the player. For example, when a player wins a computer, the prize fulfillment center might order the computer from a vendor and have it shipped to the player's home address. As another example, the prize fulfillment center might send a request to a nearby warehouse and have the prize delivered to a location in the casino where the player can pick up the prize." In this embodiment, the gaming machine provides prize redemption by sending prize information to a remote server that is used to transfer the prize to the player.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-13, 21-44 U.S.C. 103 (a) as being unpatentable over Stupak et al. (5, 851, 147) in view of Kelly (US patent No. 6015344). The rejection is respectfully traversed.

As is clear from the background and specification, Stupak describes method of allowing a game player to change the odds of winning individual cash awards in a combination of cash awards defined by a payable on the gaming machine. As Examiner has noted, Stupak does not teach selecting or awarding non-cash prizes. Kelly describes awarding and redeeming non-cash prizes.

In Kelly, when a non-cash prize is awarded as one of the outcomes of a game played and when the non-cash prize is awarded based on the outcome of that game only and independent of any previous games played on the gaming machine (Kelly refers to these prizes as "instant prizes", the game player is not allowed to select which instant prize can be won for the game.

This differs from the present invention because the game player of the present invention is allowed to select a non-cash prize that may be won as a result of the outcome of game of chance played immediately followed the selection of the non-cash prize. As described in the remaining claims of the present invention, the gaming machine is operable to allow a game player to select a non-cash prize and to award the selected non-cash prize as a result of only the game of chance to be played following the prize selection and independent of any previous games of chance played on the gaming machine.

Further, in Kelly, when a player has accumulated enough tickets, the gaming machine allows a player to redeem a prize from a selection of prizes based upon how many tickets they have accumulated during previous game plays. In contrast, in the present invention, the gaming machine is operable to only redeem selected non-cash prizes that are awarded as a result of only the game of chance to be played following the prize selection and independent of any previous games of chance played on the gaming machine. Thus, the present invention allows pre-selection of non-cash prizes that are awarded as a result of the game of chance immediately following the selection and Kelly does not while Kelly allows selection from a number of prizes for redemption based upon how many tickets a player has accumulated in previous games while the present invention does not. Therefore, the combination of Stupak and Kelly does not teach the limitations of the remaining claims. Further, the award and redemption methods of Kelly, which do not provide selection of instant prizes and are designed to allow a player to select from a number of non-cash prizes for redemption teach away from the prize selection and award methods of the present invention. Therefore, since the combination Stupak and Kelly do not teach the limitations of the present invention as recited in the remaining claims and Kelly teaches away from the present invention, the combination of Stupak and Kelly can't be said to render obvious the invention as recited in claims 1-13 and 21-44 and the objection is believed overcome thereby.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP


David P. Olynick
Reg. No.: 48,615

P.O. Box 778
Berkeley, CA 94704-0778
510-843-6200

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